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**JUN 07 2004**

**OFFICE OF PETITIONS**

In re Application of  
Schwartz, et al.  
Application No. 08/418,286  
Filed: 7 April, 1995  
Attorney Docket No. (None)

ON PETITION

This is a decision on the petition filed on 25 March, 2003, to revive the above-identified application under 37 C.F.R. §1.137(b)

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTE:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(b) (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)";
- (2) Thereafter, there will be no further reconsideration of this matter.
- (3) Petitioner's submissions suggest a lack of familiarity with practice before the Office. Petitioner may wish to seek the guidance of an individual registered to practice before the Office, which information may be found at [www.uspto.gov](http://www.uspto.gov).

### BACKGROUND

The record reflects that:

- Petitioners failed to reply timely and properly to the final Office action mailed on 27 February, 1996, with a reply due (absent a request and fee for extension of time) on or before Monday, 27 May, 1996;
- in late May 1996, the Office accepted Petitioners' Revocation of Power of Attorney from their former agent and Petitioners undertook prosecution *pro se*;
- following Petitioner's reply filed on 5 May, 1996, which reply did not place the application in condition for allowance, the Examiner mailed an Advisory Action on 3 June, 1996;
- the application was deemed abandoned after midnight 27 May, 1996;
- Notice of Abandonment was mailed on 1 October, 1996;
- the original petitions under 37 C.F.R. §1.181 and §1.137(a) alleged as the basis of their claim of unavoidable delay over the seven years and nearly seven months between the due date of their reply and the filing of the original petition (in March 2003, to withdraw the holding of abandonment) that Petitioners had to go to court to seek copies of their papers from their former agent (copies of their court documents were submitted);
- the petition under 37 C.F.R. §1.181 was dismissed on 4 November, 2003, and the petition under 37 C.F.R. §1.137(a) was dismissed on 20 February, 2004;
- as of this writing, **Petitioners still have not submitted a proper reply to the final Office action** of 27 February, 1996, in that—with the original petition under 37 C.F.R. §1.137(a) Petitioners submitted a terminal disclaimer (and fee) and a document, which, while it may be intended as a reply to the 23 May, 2003, Office action, is not a proper reply in that it is not a Notice of Appeal, a CPA or RCE, and it does not *prima facie* place the application in condition for allowance (see: MPEP §711.03(c)).

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup> Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup>

And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>

Petitioners have filed a petition (with fee), submitted a terminal disclaimer (with fee) and made the statement of unintentional delay, however, **Petitioners have failed to file the required reply**, as discussed above.

Because this petition was not as of this writing a grantable petition, the terminal disclaimer filed

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G.* 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

25 March, 2003, under 37 C.F.R. §1.137(d) has not as yet been entered and made of record.<sup>7</sup>

Petitioners have failed to satisfy the requirements of 37 C.F.R. §1.137(b).

### CONCLUSION

Therefore, the instant petition under 37 C.F.R. §1.137(b) hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)<sup>8</sup>  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (703) 872-9306 (IFW Formal Filings)  
ATTN.: Office of Petitions

By hand: Customer Service Window  
Lobby/Room 1B03  
Crystal Plaza Two  
2011 South Clark Place  
Arlington, VA 22202

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<sup>7</sup> The regulations at 37 C.F.R. §1.137(d)(1) state that a terminal disclaimer filed pursuant to this rule must dedicate to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of: 1) the period of abandonment of the application; or 2) the period extending beyond twenty years from the date on which the application for the patent was filed in the United States, or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121 or 365(c), from the date on which the earliest such application was filed. Effective 20 September, 2000 (65 Fed. Reg. 54674, 8 September, 2000).

<sup>8</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", written over the printed name.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

Encl: Notice of Appeal  
Section of MPEP 71103 (with forms)